

REMARKS

[0001] Applicants would like to thank Examiners Alvesteffer and Hailu for the interview held on Friday, October 5, 2007. In that interview, the parties discussed the proposed amendments and the validity of Chiang (defined below) for a §103(a) rejection. The parties discussed Bach (defined below) in view of a proposed amendment moving Claim 3 into Claim 1. The parties agreed that Bach fails to teach or disclose the teachings of Claim 3. The Examiners indicated that the Claims, as amended, appeared to overcome the art of record. The Examiners indicated that an updated search would be required. The parties agreed that, provided Applicants furnish a proper demonstration of common ownership, Chiang is not a valid §103(a) reference.

[0002] Applicants wish to bring to the Examiner's attention that US Patent App. No. 10/766,336 (the present application) includes similar subject matter, is commonly owned, and/or includes common inventors with US Patent App. No. 10/244,710, US Patent App. No. 10/244,722, US Patent App. No. 10/440,779, US Patent App. No. 10/668,740, US Patent App. No. 10/764,722, US Patent App. No. 11/083,507, US Patent App. No. 11/494,017, and US Patent App. No. 10/244,711.

[0003] Claims 1-40 are pending in this application. Claims 1 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,781,739 to Bach et al.(hereinafter "Bach '739"). Claims 1, 2, 20, 29, 39, and 40 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application 2004/0054969 to Chiang et al. (hereinafter Chiang). Claims 3-6, 12-15, 21-24, and 30-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chiang and U.S. Patent 6,141,660 to Bach et al. (hereinafter Bach '660). Claims 7-8, 16-18, 25-26, and 34-35 are rejected under § 103(a)

as being unpatentable over Chiang, in view of Bach '660 and U.S. Patent Application 2002/0078255 to Narayan. Claims 9, 27, and 36 are rejected under §103(a) as being unpatentable over Chiang in view of U.S. Patent 6,560,639 to Dan et al. (hereinafter Dan). Claims 10, 28, and 37 are rejected under §103(a) as being unpatentable over Chiang in view of U.S. Patent Application 2004/0230987 to Snover et al. (hereinafter Snover). Claims 19 and 38 are rejected under §103(a) as being unpatentable over Chiang, Bach '660, and Bach '739. Applicants have amended Claims 1, 4, 6-7, 20, 22, 24-25, 29, 39, and 40. Applicants have additionally canceled Claims 3, 21, and 30.

AMENDMENTS TO CLAIMS

[0004] Claim 1 is amended to specify that the apparatus further comprises an interface configured to execute the import module, the metadata generator, and the code generator in response to a parameter set provided as a single input to the interface. Applicants note that the amendment reflects substantially the limitations of canceled Claim 3, with the exception that limitation as drafted is directed to an interface, as opposed to a command-line interface. Support for the amendment is found in the specification at paragraphs 61 and 68.

[0005] Claims 4, 6, and 7 are amended to provide proper dependencies for the claims in light of the cancellation of Claim 3 and the amendment to Claim 1.

[0006] Claim 20 is amended to specify that the utility further comprises an interface configured to receive a parameter set and provide feedback regarding automatic generation of the web interface, the parameter set provided as a single input to the interface. Applicants note that the amendment reflects substantially the limitations of

canceled Claim 21, with the exception that limitation as drafted is directed to an interface, as opposed to a command-line interface. Support for the amendment is found in the specification at paragraphs 61 and 68.

[0007] Claims 22, 24, and 25 are amended to provide proper dependencies for the claims in light of the cancellation of Claim 21 and the amendment to Claim 20.

[0008] Claim 29 is amended to specify the inclusion of a command-line interface accepting a parameter set provided as a single input. This amendment reflects the incorporation into Claim 29 the limitation of canceled Claim 30. Canceled Claim 30 provides the basis for the amendment.

[0009] Claim 39 is amended to include means for accepting a parameter set provided as a single input. Such means are shown in Figure 3, item 302 (Command-line interface). Claim 40 is amended to include accepting a parameter set provided as a single input. Support for this amendment is found in the specification at least at paragraph 65.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. §102(b) and § 102(e)

[0010] Claims 1 and 11 stand rejected under § 102(b) as being anticipated by Bach '739. Claims 1, 2, 20, 29, 39, and 40 are rejected under § 102(e) as being anticipated by Chiang. Applicants respectfully disagree. It is well settled that under 35 U.S.C. §102 “an invention is anticipated if... all the claim limitations [are] shown in a single prior art reference. Every element of the claimed invention **must be literally present**, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Applicants have amended independent

Claims 1, 20, 29, 39, and 40 and canceled claims 3, 21, and 30 from further consideration in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present amendments and cancellations are only for facilitating expeditious prosecution of the allowable subject matter noted by the Examiner. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Applicants respectfully assert that neither Bach '739 nor Chiang teach the limitations of independent Claims 1, 20, 29, 29, or 40 as amended.

[0011] As noted in the Office Action, Chiang does not teach an interface configured to execute the import module, metadata generator, and code generator in response to a parameter set provided as a single input to the interface. Applicants further note that Bach '739 does not teach an interface which receives a parameter set as a single input and executes the listed modules. As such, neither Bach '739 nor Chiang teach all of the limitations of the Independent Claims 1, 20, 29, or 40 as amended. Applicants respectfully assert that these Claims overcome their respective § 102(b) and § 102(e) rejections.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

[0012] Claims 3-19, 21-28, and 30-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chiang and at least one other reference. Claims 3, 21, and 30 have been canceled. As to the remaining rejections, Applicants note that Chiang is invalid prior art for a § 103(a) rejection. As a result, the §103(a) rejections listed in the Office Action, each of which relies on Chiang, fail.

[0013] Section 103(c)(1) states that: “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

[0014] The present application was filed on January 28, 2004. Chiang was published on March 18, 2004. As noted by the Examiner, Chiang qualifies as prior art under § 102(e). Applicants further note that Chiang qualifies as prior art only under § 102(c). The subject matter of Chiang, as of January 28, 2004, was owned by International Business Machines (IBM), as was the claimed invention. As a result, Chiang does preclude patentability under § 103. *See, e.g.*, MPEP 706.02(l).

[0015] Applicants hereby assert that Chiang and the present application (appl. no. 10/766,336) were, at the time the invention of the present application was made, owned by IBM or subject to an obligation of assignment to IBM. Applicants further note that this statement alone is sufficient evidence to disqualify Chiang from being used in a rejection under 35 U.S.C. § 103(a) against the claims of the present application. *See, MPEP §706.02(l)(2)(II)* (“Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the

invention was made, owned by, or subject to an obligation of assignment to, the same person").

[0016] Because Chiang is invalid art against the claims of the present application, and as every §103(a) rejection provided in the Office Action relies on Chiang, Applicants respectfully submit that the Claims 3-19, 21-28, and 30-38 are allowable over the Examiner's §103(a) rejection.

CONCLUSION

[0017] As a result of the presented amendments and remarks, Applicants assert that Claims 1-2, 4-20, 22-29, and 31-40 are patentable and in condition for prompt allowance. Should the Examiner require additional information, Applicants respectfully request that the Examiner notify them of any such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

Date: October 26, 2007

Kunzler & McKenzie
8 E. Broadway, Suite 600
Salt Lake City, Utah 84101
Telephone: 801/994-4646

/David J. McKenzie/

David J. McKenzie
Reg. No. 46,919
Attorney for Applicants